UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,177	02/12/2001	Robert Anthony Luciano JR.	GAM-01-002	2454

7590 05/28/2004

Jonathan T. Velasco
c/o Sierra Design Group
300 Sierra Manor Drive
Reno, NV 89511

EXAMINER	
ENATSKY, AARON L	

ART UNIT	PAPER NUMBER
3713	

DATE MAILED: 05/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/782,177	LUCIANO ET AL.	
	Examiner	Art Unit	
	Aaron L Enatsky	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 March 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-25,27,28,31,32,34-37,52-54,58-68,73,87 and 88* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-25,27,28,31,32,34-37,52-54,58-68,73,87 and 88* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Examiner acknowledges receipt of amendment on 03/15/04. The arguments set forth in the response are addressed herein below. Rejections based upon this prior art are contained herein below. Furthermore, the prior art rejections of record are being maintained for the reasons set forth in the response to argument section herein.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21-25, 27-28, 31-32, 34-37, 60-68, and 73 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 21-36 and 60-65 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are between: a first through a fourth bonus game display. Claims 21 and 60 appears to be a disjointed set of elements that are not linked together to enable one of ordinary skill to build the instant invention. Individual elements that Applicant describes are a first through a fourth bonus game display. Applicant has described the 5 different display mechanisms, but only the primary game and the first bonus game are directly related. The third and fourth bonus game elements have no triggering mechanisms to situate operation

within the game machine. Applicant appears to have no clear recitation of how certain game functionality is performed or in this case steps on how to reach some final or intermediary game outcome.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21-25, 27, 31, 34, and 60-65 are rejected under 35 U.S.C. 102(b) as being anticipated by Melen et al. '030 (Hereafter, Melen). Melen teaches a primary game and a countdown game (1:30-48), a countdown indicator with a plurality of stop positions (1:49-52), a prize indicator which allows accumulation of prize values (2:33-44), a prize display and accumulated prize value (Fig. 1 ref. 7), a plurality of winning and non-winning stop positions associated with a countdown indicator (Fig. 1 ref. 4), a countdown indicator having an initial position that gets reset in a non-triggering game event of a predetermined number (1:110-116), the countdown indicator adjusts according to a triggering game event (1:116-124), countdown adjuster and prize indicator activated only at a game triggering event (1:125-2:25), indicating prize values at random events (2:17-25), a countdown adjuster to adjust countdown indicator (Fig. 1, ref. 6), the primary game is adjusted through the adjustment of the counter (1:125-2:11), and the countdown adjustments are made through a random event (1:125-2:11).

In regard to the apparatus claims, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the

claimed apparatus from a prior art apparatus satisfying the claimed structural limitation Ex Parte Masham, 2 USPQ2d 1647 (1987). A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Thus Melen is capable of being used to display a plurality of bonus game display and the structural limitations dictated by claims 21-25, 27, 31, and 34 are capable of being performed by Melen.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 28 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Melen as applied to claims 21-25, 27, 31, 34, and 60-65 above, and further in view of Schneier et al. '398 (Hereafter, Schneier). Melen teaches the claimed limitations as discussed above, but does not teach providing a predetermined result from a finite pool of outcomes. Schneier teaches providing a predetermined result from a finite pool of outcomes so that game device management knows exactly what outcomes were provided (9:35-42). One would be motivated to modify the gaming machine taught by Melen to include the predetermined results taught by Schneier so that gaming management would knows exactly what outcomes were provided to

increase security and prevent fraud. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Melen to include the predetermined results taught by Schneier to increase management awareness and game security.

Claims 35-37, 66-68, 72, and 87-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Melen as applied to claims 21-25, 27-28, 31-32, 34, and 60-65 above, and further in view of Takemoto et al. '034 (Hereafter, Tak). Melen teaches the claimed limitations as discussed above in addition to a countdown indicator adjuster comprising a wheel (Fig. 1, ref 6), but fails to disclose all of the indicators comprising wheels in a concentric format. Tak teaches all game elements indicators comprising concentric wheels (Figures 1-3). The inventions are related in that both are gambling game machines and both already encompass wheels or a wheel for an indicator where one would be motivated to modify Melen to use all indicators on concentric wheels taught by Tak to allow all figures to be clearly seen to give an game participant a reference for a better game understanding (3:003). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Melen to use the concentric wheels indicators taught by Tak to give a player increase enjoyment through a better understanding of the game being played.

Response to Arguments

Applicant's arguments filed 03/15/04 have been fully considered but they are not persuasive. Applicant has provided amended claims that are more clear than previous claims, but still do not properly link certain game elements for a cohesive method or apparatus. Without such, Applicant's arguments on how the instant invention and the references differ in how the

elements relate to each other are not persuasive. Thus, it is also held that Applicant's arguments are not commensurate in scope with that which is currently claimed. Therefore, Applicant's disjointed game elements still read on cited prior art and the prior rejection is maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

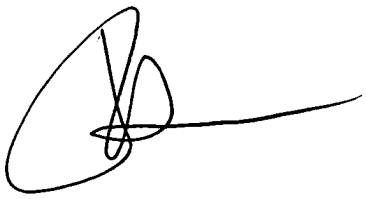
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron L Enatsky whose telephone number is 703-305-3525. The examiner can normally be reached on 8-6 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on 703-308-1327. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ALE



JESSICA HARRISON
PRIMARY EXAMINER